

### III. REMARKS

1. Claims 1, 20, 23, 24, 25 and 33 are amended.
2. Applicant appreciates the indication of allowable subject matter in claims 10, 11, 18, 19, 21, 22, 41 and 42.
3. Claims 1, 3, 5, 7-9, 12, 13, 20, 23-26 and 33 are patentable under 35 USC 103(a) over the combination of Mizikovsky et al. (US 5,559,860, "Mizikovsky"), Kang et al. (US 5,058,150, "Kang") and Bremer et al. (US 6,018,671, "Bremer"). Claim 1 recites sending a reply to said caller, said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication. At least this feature is not disclosed or suggested by the combination of Mizikovsky, Kang and Bremer.

Mizikovsky discloses that various types of accessory devices 50 may be coupled to the mobile station and may be activated when an incoming call is received from a calling party to which the user previously has assigned an accessory device response (Col. 6, L. 52-56). These accessory devices merely "answer" the incoming call and nothing more. The mere presentation of a prerecorded voice recording such as with an answering machine or a tone generated by a fax machine cannot reasonably be considered a reply as claimed by Applicant. Applicant's claim 1 recites "said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication." There is simply no disclosure or suggestion in Mizikovsky of sending a reply that includes a temporally dependent activity status of a user of the portable terminal. Combining Mizikovsky with Kang fails to remedy this deficiency.

Kang is substantially similar to Mizikovsky in that a mere answering machine message is played upon receipt of a call. In Kang a user of a vehicle radio-telephone selects one of three modes for answering a call. The first mode provides an alternate number to contact the user the second mode indicates that the user will return the call shortly and the third mode allows the caller to leave a voice message (Col. 5, L. 5-21). There is absolutely no disclosure or suggestion in Kang of "sending a reply to said caller, said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication" as recited in Applicant's claim 1. Thus, the combination of

Mizikovsky and Kang does not disclose each and every features of Applicant's claim 1. Combining Mizikovsky and Kang with Bremer fails to remedy the above-noted deficiency of Mizikovsky and Kang.

Bremer merely discloses that a prerecorded message is generated from a memory 126 and played for the calling party to inform the caller that the user is occupied, but will answer the call shortly (Col. 1, L. 60-62). There is no disclosure or suggestion in Bremer that the prerecorded message includes "a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication" as recited in Applicant's claim 1. All that is disclosed in Bremer is that a controller displays optional reply messages such as a default message telling the caller they are on hold and the call will be answered shortly, a recorded message that the called party can not answer soon, but the caller can leave a message, a message that the called party is unavailable, a message giving the caller the option to forward the call to another number or a network voice mail service or any other message (Col. 3, L. 61 – Col. 4, L. 4). There is nothing in Bremer that would suggest that any of these messages include a "temporally dependent activity status of a user of the portable terminal" as recited in Applicant's claim 1.

Thus, claim 1 is patentable over the combination of Mizikovsky, Kang and Bremer because their combination does not disclose or suggest "sending a reply to said caller, said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication" as recited in claim 1. Claims 20, 23, 24, 25 and 33 are patentable over the combination of Mizikovsky, Kang and Bremer for reasons substantially similar to those described above with respect to claim 1. Claims 3, 5, 7-9, 12, 13, and 26 are patentable at least by reason of their respective dependencies.

4. Claims 2 and 6 are patentable over the combination of Mizikovsky, Kang, Bremer and Jambhekar et al. (US 5,848,356, "Jambhekar") under 35 USC 103(a). Claims 2 and 6 depend from claim 1. The combination of Mizikovsky, Kang and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Kang, Bremer and Jambhekar cannot as well. Thus, claims 2 and 6 are patentable at least by reason of their respective dependencies.

5. Claim 14 is patentable under 35 USC 103(a) over the combination of Mizikovsky, Kang, Bremer and Villa-Real et al. (US 4,481,382, "Villa-Real"). Claim 14 depends from claim 1. The

combination of Mizikovsky, Kang and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Kang, Bremer and Villa-Real cannot as well. Thus, claim 14 is patentable at least by reason of its dependency.

6. Claims 15-17 are patentable under 35 USC 103(a) over the combination of Mizikovsky, Kang, Bremer and Wolff et al. (US 5,327,486, "Wolff"). Claims 15-17 depend from claim 1. The combination of Mizikovsky, Kang and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Kang, Bremer and Wolff cannot as well. Thus, claims 15-17 are patentable at least by reason of their respective dependencies.

7. Claims 1, 3, 5, 7-9, 12, 13, 20, 23-26 and 33 are patentable under 35 USC 103(a) over the combination of Mizikovsky and Bremer. Again, claim 1 recites sending a reply to said caller, said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication. At least this feature is not disclosed or suggested by the combination of Mizikovsky and Bremer.

Mizikovsky discloses that various types of accessory devices 50 may be coupled to the mobile station and may be activated when an incoming call is received from a calling party to which the user previously has assigned an accessory device response (Col. 6, L. 52-56). These accessory devices merely "answer" the incoming call and nothing more. The mere presentation of a prerecorded voice recording such as with an answering machine or a tone generated by a fax machine cannot reasonably be considered a reply as claimed by Applicant. Applicant's claim 1 recites "said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication." There is simply no disclosure or suggestion in Mizikovsky of sending a reply that includes a temporally dependent activity status of a user of the portable terminal.

The Examiner asserts that it would have been obvious to one skilled in the art to combine the mobile station of Mizikovsky with the peripheral devices disclosed therein based on *In re Larson*, 144 USPQ 347. However, this assertion is not supported by the disclosure of Mizikovsky. All that is disclosed in Mizikovsky is that the peripheral or accessory devices 50 may be coupled to the mobile station and nothing more (Col. 6, L. 52-53). There is absolutely nothing in Mizikovsky to suggest that the coupling "rigidly secures" the mobile station to the

peripheral device so as to form a "single unit." It is respectfully submitted that the Examiner's reliance on *in re Larson* is misguided as the court in that case was interpreting the meaning of the term "integral". There is absolutely nothing in Mizikovsky that discloses or suggests the mobile station and peripheral accessories or devices are "integral" with one another. Again, all that is disclosed in Mizikovsky is that the mobile station and peripheral or accessory devices may be coupled to each other and nothing more. It is further noted that the peripheral devices include devices such as answering machines and fax machines. Integration of these devices into the mobile station would effectively create a device that is no longer mobile given the size and power requirements of these peripheral devices. Thus, it would not be obvious for one skilled in the art to integrate the peripheral or accessory devices of Mizikovsky with the mobile station as suggested by the Examiner. Combining Mizikovsky with Bremer fails to remedy the above-noted deficiencies of Mizikovsky.

As described above, Bremer merely discloses that a prerecorded message is generated from a memory 126 and played for the calling party to inform the caller that the user is occupied, but will answer the call shortly (Col. 1, L. 60-62). There is no disclosure or suggestion in Bremer that the prerecorded message includes "a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication" as recited in Applicant's claim 1. All that is disclosed in Bremer is that a controller displays optional reply messages such as a default message telling the caller they are on hold and the call will be answered shortly, a recorded message that the called party can not answer soon, but the caller can leave a message, a message that the called party is unavailable, a message giving the caller the option to forward the call to another number or a network voice mail service or any other message (Col. 3, L. 61 – Col. 4, L. 4). There is nothing in Bremer that would suggest that any of these messages include a "temporally dependent activity status of a user of the portable terminal" as recited in Applicant's claim 1.

Thus, claim 1 is patentable over the combination of Mizikovsky and Bremer because their combination does not disclose or suggest "sending a reply to said caller, said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication" as recited in claim 1. Claims 20, 23, 24, 25 and 33 are patentable over the combination of Mizikovsky and Bremer for reasons substantially similar to those described above with respect to claim 1. Claims 3, 5, 7-9, 12, 13, and 26 are patentable at least by reason of their respective dependencies.

8. Claims 2 and 6 are patentable under 35 USC 103(a) over the combination of Mizikovsky, Bremer and Jambhekar et al. (US 5,848,356, "Jambhekar"). Claims 2 and 6 depend from claim 1. The combination of Mizikovsky and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Bremer and Jambhekar cannot as well. Thus, claims 2 and 6 are patentable at least by reason of their respective dependencies.

9. Claim 14 is patentable under 35 USC 103(a) over the combination of Mizikovsky, Bremer and Villa-Real. Claim 14 depends from claim 1. The combination of Mizikovsky and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Bremer and Villa-Real cannot as well. Thus, claim 14 is patentable at least by reason of its dependency.

10. Claims 15-17 are patentable under 35 USC 103(a) over the combination of Mizikovsky, Bremer and Wolff. Claims 15-17 depend from claim 1. The combination of Mizikovsky and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Bremer and Wolff cannot as well. Thus, claims 15-17 are patentable at least by reason of their respective dependencies.

11. Claims 1, 3, 5, 7-9, 12, 13, 20, 23-26 and 33 are patentable under 35 USC 103(a) over the combination of Mizikovsky, Wang and Bremer. Claim 1 recites sending a reply to said caller, said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication. At least this feature is not disclosed or suggested by the combination of Mizikovsky, Wang and Bremer.

Mizikovsky discloses that various types of accessory devices 50 may be coupled to the mobile station and may be activated when an incoming call is received from a calling party to which the user previously has assigned an accessory device response (Col. 6, L. 52-56). These accessory devices merely "answer" the incoming call and nothing more. The mere presentation of a prerecorded voice recording such as with an answering machine or a tone generated by a fax machine cannot reasonably be considered a reply as claimed by Applicant. Applicant's claim 1 recites "said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication." There is simply no disclosure or suggestion in Mizikovsky of sending a reply that includes a

temporally dependent activity status of a user of the portable terminal. Combining Mizikovsky with Wang fails to remedy this deficiency.

Wang merely discloses two way messaging where response signals are sent to the base station in response to receiving a message which is received by the transmitter 224 (Col. 3, L. 41-43). While these response signals may include numeric, alphanumeric, graphical or short voice responses there is absolutely no disclosure or suggestion whatsoever in Wang of "sending a reply to said caller, said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication" as recited in Applicant's claim 1. Thus, the combination of Mizikovsky and Wang does not disclose each and every features of Applicant's claim 1. Combining Mizikovsky and Wang with Bremer fails to remedy the above-noted deficiency of Mizikovsky and Wang.

Bremer merely discloses that a prerecorded message is generated from a memory 126 and played for the calling party to inform the caller that the user is occupied, but will answer the call shortly (Col. 1, L. 60-62). There is no disclosure or suggestion in Bremer that the prerecorded message includes "a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication" as recited in Applicant's claim 1. All that is disclosed in Bremer is that a controller displays optional reply messages such as a default message telling the caller they are on hold and the call will be answered shortly, a recorded message that the called party can not answer soon, but the caller can leave a message, a message that the called party is unavailable, a message giving the caller the option to forward the call to another number or a network voice mail service or any other message (Col. 3, L. 61 – Col. 4, L. 4). There is nothing in Bremer that would suggest that any of these messages include a "temporally dependent activity status of a user of the portable terminal" as recited in Applicant's claim 1.

Thus, claim 1 is patentable over the combination of Mizikovsky, Wang and Bremer because their combination does not disclose or suggest "sending a reply to said caller, said reply including a temporally dependent activity status of a user of the portable terminal and having a form selectable from a plurality of forms of communication" as recited in claim 1. Claims 20, 23, 24, 25 and 33 are patentable over the combination of Mizikovsky, Wang and Bremer for reasons substantially similar to those described above with respect to claim 1. Claims 3, 5, 7-9, 12, 13, and 26 are patentable at least by reason of their respective dependencies.

12. Claims 2 and 6 are patentable over the combination of Mizikovsky, Wang, Bremer and Jambhekar under 35 USC 103(a). Claims 2 and 6 depend from claim 1. The combination of Mizikovsky, Wang and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Wang, Bremer and Jambhekar cannot as well. Thus, claims 2 and 6 are patentable at least by reason of their respective dependencies.

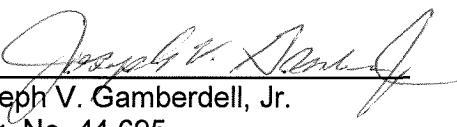
13. Claim 14 is patentable over the combination of Mizikovsky, Wang, Bremer and Villa-Real under 35 USC 103(a). Claim 14 depends from claim 1. The combination of Mizikovsky, Wang and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Wang, Bremer and Villa-Real cannot as well. Thus, claim 14 is patentable at least by reason of its dependency.

14. Claims 15-17 are patentable over the combination of Mizikovsky, Wang, Bremer and Wolff under 35 USC 103(a). Claims 15-17 depend from claim 1. The combination of Mizikovsky, Wang and Bremer does not disclose or suggest all of the features of claim 1 for the reasons described above. It is submitted that the combination of Mizikovsky, Wang, Bremer and Wolff cannot as well. Thus, claims 15-17 are patentable at least by reason of their respective dependencies.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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